

**REMARKS**

In the Office Action, claims 1-8 and 47-55 were rejected. By the present Response, claims 1-3 have been amended, and new claims 57-94 have been added. With regard to the new claims, no new matter has been added. Upon entry of the amendments, claims 1-8 and 47-94 are pending in the present patent application. Reconsideration of the rejections, and allowance of all pending claims, including the new claims, are respectfully requested.

**Double Patenting Rejection**

In the Office Action, the Examiner asserted a double patenting rejection of claims 1-8 and 47-55 as being unpatentable over claims 1-42 of U.S. Patent Application No. 09/940,065. Moreover, the Examiner emphasized that the present rejection is a *provisional* double patenting rejection.

In the interest of efficient prosecution, Applicants respectfully request that the Examiner hold in abeyance the double patenting rejection until the allowability of the claims is indicated. Although Applicants do not necessarily agree with the Examiner's rejection, Applicants will nonetheless strongly consider filing a terminal disclaimer upon indication that the pending claims are allowable. That is, Applicants respectfully request that the discussion regarding the double patenting rejection be suspended until the allowability of the claims is determined.

**Rejection Under 35 U.S.C. § 103**

Claims 1-8 and 47-55 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Henderson, (U.S. Patent No. 3,403,240). Specifically, the Examiner stated:

The Henderson reference(s) disclose(s) the features including the claimed portable induction unit with cooling. The features relied upon described above can be found in the reference(s) at: figures 2 and 3 and col. 2, line 23 – col 4, line 33. The difference between the reference(s) and the claims are as follows: Henderson does not disclose the power unit is programming power controlled. However, programming power controlled unit is well known in the induction arts for various heating. Therefore, it would have been obvious to one having ordinary skill in the art of the cited reference to recognize the power control unit of Henderson can be programmed [sic].

Applicant respectfully asserts that the instant claims are patentable over the Henderson reference, because the instant claims recite features not found in the Henderson reference.

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the modification. See *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the modification includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the reference. See *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). When a prior art reference requires a selected modification to render obvious a subsequent invention, there must be some reason for the modification other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the modification. See *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988).

As a preliminary matter, Applicants respectfully request that the Examiner provide support for the Examiner's assertion of what is "well known" in the art in accordance with M.P.E.P. § 2144.03. In the rejection, the Examiner asserted that a "programming power controlled unit is *well known* in the induction arts for various heating." (Emphasis added). The Examiner concluded that "it would have been obvious to one having ordinary skill in the art of the cited reference to recognize the power control unit of Henderson can be programed [sic]." Accordingly, Applicants seasonably traverse and challenge the Examiner's apparent use of Official Notice. Specifically, Applicants respectfully request objective evidence, such as an additional reference, in support of the Examiner's position if the rejection is to be maintained.

With regard to the Examiner's rejection of independent claim 1, Applicants strongly emphasize that the Henderson reference does *not* teach, suggest, or disclose a "programmable power source controller," as recited by amended claim 1. First, the "power control unit" of the Henderson system is simply a manual on-off switch, such as a typical light switch and, thus, not useful for the sophisticated control contemplated in the present application. Secondly, the Henderson induction heating configuration was designed no later than 1965 and is hardly conducive to the modern power source controller disclosed in the present application. Thirdly, and just as striking, no temperature feedback device is installed in the Henderson system, unlike the present embodiments, and, thus, no data is available to feed the controller. Fourthly, the Henderson system is directed to brazing (simple heating), an application that does not employ programmable temperature control. Column 1, lines 25-28 and 58-60. This is in stark contrast to the application of post-weld stress relief, for example, which benefits from complicated temperature profiles, typically including various positive and negative ramp rates. Based on the foregoing, Applicants respectfully assert that the Examiner has failed to establish a *prima facie* case of obviousness with respect to independent claim 1.

In regard to Examiner's rejection of independent claim 47, Applicants strongly assert that the Henderson reference does *not* teach, suggest, or disclose a "*power source controller* operable to control the heating of a workpiece in response to programming instructions provided by a user to produce a desired temperature profile in the workpiece," as recited by claim 47. The Examiner apparently acknowledges this deficiency, but then asserts that a programming power control unit is "well known" and that it would have been obvious to one of ordinary skill in the art to "recognize the power control unit of Henderson can be programed [sic]." Applicants respectfully, but strongly, disagree. Again, Applicants request that the Examiner provide objective evidence of the suggestion to add a programmable controller that would, for example, control the operation of the power source in accordance with entered parameters and/or operating instructions. Applicants note that the Examiner has failed to meet the evidentiary burden for asserting such a modification. Furthermore, Applicants strongly assert that such a modification is neither suggestible, desirable, nor feasible, and absolutely does not flow from the teachings of the Henderson reference. At best, the Examiner is employing hindsight reconstruction to make the modification. Accordingly, the Examiner has failed to establish a *prima facie* case of anticipation with respect to independent claim 47.

In sum, the Examiner has failed to provide objective evidence of the suggestion to add a programmable power source controller to the induction heating system disclosed in the Henderson reference. Therefore, for at least this reason, the Examiner has failed to establish a *prima facie* case of obviousness. Accordingly, Applicants respectfully submit that the subject matter of independent claim 1 (as amended) and independent claim 47, as well as the claims dependent thereon, is patentable over the cited combination. Therefore, Applicants request withdrawal of the Examiner's rejections and allowance of claims 1-8 and 47-94.

With regard to new independent claims 57, 68, 79, and 87, the Henderson reference does not teach, suggest, or disclose a programmable controller, as claimed. Therefore, new claims 47-98 are believed allowable over the Henderson reference for at least the reasons discussed above.

**Conclusion**

In view of the remarks and amendments set forth above, Applicant respectfully requests allowance of the pending claims and the added new claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

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Respectfully submitted,



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